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<div align="center">REMARKS</div>

Information disclosure statement and comment regarding application referenced therein

Applicant has submitted herewith an information disclosure statement identifying US published patent application no. 2003/0225726. Applicant's representative, Mike Dryja, and the Examiner Yves Dalencourt have been working on getting US published patent application no. 2003/0225726 allowed, and Applicant believes that the patent application has been put in condition for allowance due to Applicant's fax to the Examiner in patent application 2003/0225726 on March 16, 2008.

Furthermore, to speed allowance of the present patent application, Applicant has amended the independent claims of the present application in a similar manner to the amendments made in the patent application 2003/0225726. Applicant understands that a terminal disclaimer may have to be filed in the present patent application over the patent application 2003/0225726, and is prepared to file such a terminal disclaimer if the claims of the present application are otherwise allowable over the prior art of record.

Claim rejections under 35 USC 103

Claims 1-35 have been rejected under 35 USC 103(a) as being unpatentable over Grasso (2002/0116291) in view of Hamzy (6,623,527). Claims 1, 8, 19, and 26 are independent claims, from which the remaining claims rejected on this basis ultimately depend. Applicant submits that claims 1, 8, 19, and 26 are patentable over Grasso in view of Hamzy, such that all the pending claims are patentable over Grasso in view of Hamzy.

Claim amendments

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Claim 1 is discussed as representative of all the independent claims 1, 8, 19, and 26, insofar as patentability over Grasso in view of Hamzy. Claim 1 has been amended in two ways. First, the specific order in which the various actions are performed has been made explicit, such that certain actions are performed "prior to printing of data being initiated," and other actions are performed "after said data to be accessed has been identified." Second, the generic access instructions are sent from a first service specifically "to the enterprise resource planning system."

Applicant submits that support for these amendments is found in the present patent application for at least the same reasons that similar amendments made in patent application 2003/0225726 have support, as articulated in the fax of March 16, 2008 to the Examiner in application 2003/0225726. For convenience, these reasons are now duplicated to large extent.

First, paragraphs [0060]-[0073] at least inherently describe the method in question. For example, in paragraph [0060], a user provides input to define an image. The input is received in this paragraph as well, and data is created that described the image, where the creation of such data corresponds to configuring the data. The data is then stored in paragraph [0060], too. Thereafter, the client device performs functionality in paragraph [0062] upon receiving the generic access instructions, which implies that the generic access instructions have been sent (since they have to be sent before they can be received).

Once all of these method parts have been performed, "[n]ext, the user causes the browser to transmit an appropriate request . . . to print the target image," in paragraph [0072]. Thereafter, "[a]fter the user configures and requests printing by selecting the print button of the print dialog box 200, the second web content 36 causes the client machine 12 to generate a print job," in paragraph [0073].

Thus, where paragraphs [0060]-[0073] describe the method that have been claimed, and where the method is described such that various parts (data configuration, data storage, generic access instruction reception) are performed before the user causes a request to be transmitted to print the target image (i.e., by virtue of language such as "next" in paragraph [0072] and "after" in

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paragraph [0073]), this is how the specification supports the claim language that has been added to the claims.

That is, the claim language says that configuration and storage of data, and transmission of the at least one generic access instruction, are performed "prior to printing of data being initiated." The initiation of printing of data corresponds to the user causing the browser to transmit a request to print the target image in paragraph [0072]. Because this request is initiated after the data has been configured and stored and the generic access instruction sent/received, there is at least implicit support in the specification for the claim amendment in question.

It is noted that MPEP 2173.05(i) says that "a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support." The MPEP likewise states in an earlier section that "[t]he subject matter of [a] claim need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the description requirement." (MPEP sec 2163.02) In this respect, the MPEP notes that

> By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter.

(MPEP sec. 2163.07(a))

Second, as to the claim limitation "sending one or more generic access instructions from a first server to a client device," support is found in the specification as follows. For example, paragraph [0062] of the specification discusses what occurs when the generic access instructions in question are received – in particular, the target image 28 is stored on the client machine 12 within data storage element 20. Therefore, it is inherent that the client machine 12 has to be the entity that receives the generic access instructions, since it is the client machine 12 that performs actions responsive to these instructions.

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Why the claims as amended are patentable over Grasso in view of Hamzy

Applicant submits that the pending claims as amended are patentable over Grasso in view of Hamzy. Applicant's reasoning provided herein is substantially identical to the reasoning provided in the patent application 2003/0225726 in the office action response of January 28, 2008. This is because the claims in the patent application 2003/0225726 are substantially similar to the claims in the present patent application, such that the reasons why the claims in the present patent application are allowable are similar to the reasons that the claims in the patent application 2003/0225726 are allowable.

As to Grasso disclosing an MFD that can scan items into memory, Applicant acknowledges that Grasso does indeed disclose such a device, but nevertheless submits that this fact does not render the claimed invention at least as amended unpatentable over Grasso in view of Hamzy. The claimed invention as amended is limited to data being configured (and stored), and at least one generic instruction being sent, "prior to printing of [the] data being initiated." By comparison, the entirety of the functionality of Grasso in view of Hamzy is achieved as follows: "[t]o access the services, user 50 prints a document 120." (Grasso, para. [0058].) That is, unlike the claimed invention, in which the functionality is performed prior to printing of the data even being initiated, in Grasso in view of Hamzy, all the functionality is achieved (i.e., the services being accessed) as being predicated on a user printing a document.

Grasso says that the user 50 can access, browser, search any service "via the web site 130" and can also access services via a paper-based user interface 110 by scanning the filled-in form 122 on "MFD 110." (Para. [0059].) However, note again that to actually "access the[se] services," the user 50 must first "print[] a document 120." (Para. [0058.]) This is in contradistinction to the claimed invention.

In this respect, usage of an MFD is described in Grasso in that "[w]hen an item is presented for printing to a MFD, the MFD can store an image of the item printed." (Para. [0032].) It may be this feature of an MFD that allows a user 50 to access services *after* "user 50

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prints a document 120" (para. [0058]), and it is this feature of the MFD that permits the user one way by which to access the services after the user has printed a document (para. [0059]). <u>That is, nowhere in Grasso, and thus nowhere in Grasso in view of Hamzy, is it disclosed that the services are provided user *prior to printing of a document.*</u> Rather, Grasso in view of Hamzy makes explicitly clear that these services are provided only responsive to printing of a document. (See again para. [0058] of Grasso.)

Therefore, the fact that Grasso discloses an MFD does not mitigate the fact that Grasso in view of Hamzy teaches, suggests, and discloses a process by which services are provided responsive to a user printing a document, in contradistinction to the claimed invention. Applicant respectfully submits that the Examiner is attempting to read limitations into Grasso in view of Hamzy that are found only in the claimed invention, and that have no basis in Grasso in view of Hamzy. The simple fact is that Grasso in view of Hamzy does not disclose functionality that is performed "prior to printing of data being initiated," in contradistinction to the invention.

Claim rejections under 35 USC 102

Claims 1-35 have been rejected under 35 USC 102(b) as being anticipated by Verma (2003/0115326). Applicant notes again that the present claims are substantially similar to those in the patent application 2003/0225726. Therefore, Applicant's reasoning provided herein is substantially identical to the reasoning provided in the patent application 2003/0225726 in the office action response of January 28, 2008.

Applicant notes that each of the claims, by explicit recitation in the independent claims and by implicit recitation in the dependent claims due to the dependent claims depending from the independent claims, is limited to a printing apparatus or a printer having an embedded web server or otherwise including a web server. Verma does not actually disclose such a printer or a printing apparatus. For instance, in FIG. 1, printers 106, 108, 114, and 116 are communicatively coupled to an "appliance" 102, where it is this appliance 102 (and not any of the printers) that includes an

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embedded web server or otherwise includes a web server. (E.g., in para. [0102], the client 222 points its browser to the URL address of the appliance 200, not of any of the printers 106, 108, 114, and 116; see also FIG. 14, in which the web server 206 is located in the appliance 200, not in the printer 1408; and, see also FIG. 11, in which the appliance 200 is communicatively coupled to a number of printers 1102, 1104, and 1006.) Therefore, Verma cannot be said to anticipate any of the claims, for this reason alone.

Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mike Dryja, Applicants' Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

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Date

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